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June 20, 2002

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ART UNIT 1636

Commissioner for Patents
Washington, D.C. 20231

TECH CENTER 1600/2900

Re: U.S. Patent Application
Appl. No. 09/397,967; Filed: September 17, 1999
For: **Jak Kinases and Regulation of Cytokine Signal Transduction**
Inventors: Ihle *et al.*
Our Ref: 0656.0370004/LBB/JAH

Sir:

Transmitted herewith for appropriate action are the following documents:

1. SKGF Cover Letter;
2. Supplemental Reply Under 37 C.F.R. § 1.111; and
3. Return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

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The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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LBB/ybh

Enclosures

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SKGF Rev. 2/15/02 dew



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

IHLE *et al.*

Appl. No. 09/397,967

Filed: September 17, 1999

For: **Jak Kinases and Regulation of
Cytokine Signal Transduction**

Confirmation No.: 9463

Art Unit: 1636

Examiner: Nguyen, Q.

Atty. Docket: 0656.0370004/LBB/JAH

Supplemental Reply Under 37 C.F.R. § 1.111

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action mailed May 20, 2002 (PTO Prosecution File Wrapper Paper No.13), Applicants submit the following Remarks.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. If, however, additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 19-0036.

Remarks

In the Office Action mailed May 20, 2002, the Examiner alleged that the reply filed on February 26, 2002 was not fully responsive to the prior office action. Applicants respectfully traverse this assertion.

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The Examiner's statement was made based on Applicants' request for the rejection on Obviousness-Type Double Patenting be held in "abeyance." This request was in fact, fully responsive to the Office Action.

Applicants further argue that an obviousness-type double patenting rejection should only be made when the claims of the current application would be obvious in view of the claims U.S. Patent No. 6,136,595 (cited by the Examiner). This is not the case. The claims of the current application are not obvious in view of the claims of U.S. Patent No. 6,136,595.

The Federal Circuit in *General Foods Corp. v. Studiengesellschaft KmBH*, 23 USPQ2d 1839 (Fed. Cir. 1992) reiterated the necessity of comparing *only* the claims in the applications rejected on obviousness-type double patenting grounds. In order for the obviousness-type double patenting rejection to stand the Examiner must show that claims 26, 30, 35-37, 39-42, 45-47 and 49-51 are obvious in view of claims 1-8 of U.S. Patent No. 6,136,595. This has not been done. Therefore, the obviousness-type double patenting rejection is incorrect and should be withdrawn.

Reconsideration of this Application is respectfully requested.

Conclusion


All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (202) 371-2589.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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Date: June 20, 2002

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